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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/647,235	08/26/2003	Ryoji Watanabe	116939	1746

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EXAMINER

PAHNG, JASON Y

ART UNIT	PAPER NUMBER
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3725

DATE MAILED: 03/31/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/647,235

Applicant(s)

WATANABE ET AL. 

Examiner

Jason Y Pahng

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-12 is/are pending in the application.
- 4a) Of the above claim(s) 12 is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-11 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- 1) ☒ Certified copies of the priority documents have been received.
 - 2) ☐ Certified copies of the priority documents have been received in Application No. ____.
 - 3) ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|----------------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. ____. |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>8/26/2003</u> . | 6) <input type="checkbox"/> Other: ____. |

DETAILED ACTION

Election/Restrictions

Applicant's election with traverse of Group I (claims 1-11) in the reply filed on March 2, 2003 is acknowledged.

The traversal is on the ground(s) that the recited features are similar. Applicant argues, for example, that claims 1 and 12 recite similar features. This is not found persuasive because claim 1 and 12 are two patentably distinct inventions as set forth in the last Office action. For example, the shredder of claim 1 may be used to shred items other than the image display member. However, the process of claim 12 may only be used to shred an image display member.

Additional restriction requirement of Group I made in the last Office action is withdrawn in view of Applicant's arguments.

The requirement of election between Group I (claims 1-11) and Group II (claim 12) is still deemed proper and is therefore made FINAL.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

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(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 2, 3, 5, and 6 are rejected under 35 U.S.C. 102(b) as being anticipated by Hatanaka (US 4,192,467).

With regard to claims 1 and 2, Hatanaka discloses an image display member or paper shredder including:

1. a destroy process unit (52) for destroying data stored in an image display member (A); and
2. a shredding process unit (94) for shredding the image display member.

With regard to claim 3, Hatanaka discloses data stored in a data storage device or a paper of the image display member (A).

With regard to claim 5, Hatanaka discloses a destroy process unit (52) destroying the data storage device or a paper physically.

With regard to claim 6, Hatanaka discloses an insertion port (46) from which the image display member (A) is inserted. The destroy process unit (52) is disposed closer to the insertion port (46) than the shredding process unit (94).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 4, 7, 8, 10, and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hatanaka (US 4,192,467) in view of Abramson (US 4,931,770). Claim 4 is an obvious variation of the invention of claim 5. Claim 4 calls for the destroy process unit to use an electric or magnetic field instead of physical means in order to destroy data. In a closely related art, Abramson teaches that any one of abrasive, cutting, chemical, or magnetic process may be used in order to destroy data (column 2, lines 26-37). Therefore, it would have been obvious to one skilled in the art at the time the invention was made to provide Hatanaka with any one of the means taught by Abramson, including a magnetic destroy unit.

With regard to claim 7, Hatanaka discloses the shredding process unit (34, 36) followed by a data destroy unit.

Claim 8 does not add any further limitation to claim 4. The use of electric field claimed in claim 4 would inherently include application of voltage. The use of electric or magnetic field is considered obvious variations of a single invention as claimed in claim 4.

With regard to claim 10, Hatanaka discloses a sensor (172) for sensing a data storage device (paper portion of the document) of the image display unit (A) or document. Hatanaka also discloses a control unit (Figure 7) for controlling the destroy process unit.

With regard to claim 11, Hatanaka discloses a sensor (172) for sensing an image display member (A). Hatanaka also discloses a control unit (Figure 7) for controlling the destroy process unit.

Claim 9 is rejected under 35 U.S.C. 103(a) as being unpatentable over Hatanaka (US 4,192,467) in view of Wang et al. (US 2003/0234249). Claim 9 is an obvious variation of the invention of claim 5. Claim 9 calls for the destroy process unit to use an electromagnetic wave instead of physical means in order to destroy data. In a closely related art, Wang teaches that crushing [0004] or electromagnetic wave [0012] may be used in order to destroy data. Therefore, it would have been obvious to one skilled in the art at the time the invention was made to provide Hatanaka with either of the means taught by Wang, including a electromagnetic wave means. The recitation of overwriting another data is a matter of an obvious design choice, and official notice is taken.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jason Y Pahng whose telephone number is 571 272 4522. The examiner can normally be reached on 9:00 AM - 7:00 PM, Monday-Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Derris Banks can be reached on 571 272 4419. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

JYP

A handwritten signature in black ink, appearing to read 'D. Banks', with a long horizontal line extending to the right.

DERRIS H. BANKS
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3700